

REMARKS

Claims 1-20 are pending, of which claims 1, 13, and 18 have been amended. No new matter has been added by the amendments presented herein. Reconsideration and allowance of this application in light of the foregoing amendments and the following remarks are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-6, 11-14, and 18-20 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,907,082 to Richards ("Richards") in view of U.S. Patent No. 4,747,140 to Gibson ("Gibson"). Claims 7, 8, 10, and 15-17 stand rejected under 35 U.S.C. §103 as being unpatentable over Richards in view of Gibson, and further in view of U.S. Patent No. 5,673,293 to Scarpa et al. ("Scarpa"). Claim 9 stands rejected under 35 U.S.C. §103 as being unpatentable over Richards in view of Gibson and further in view of U.S. Patent No. 6,826,247 to Elliott et al. ("Elliott").

Applicants respectfully traverse the subject rejections on the grounds that the references are defective in establishing a prima facie case of obviousness with respect to the claims.

As the PTO recognizes in MPEP § 2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. The Combination Does Not Teach the Claimed Subject Matter

The Richards and Gibson references cannot be applied to reject independent claims 1, 13, and 18 under 35 U.S.C. §103 because the combination does not render the claimed subject matter obvious.

In particular, the combination of Richards and Gibson fails to teach, suggest, or render obvious at least the following elements recited in independent claim 1, as amended:

first, second, and third digital filters adapted to receive the digital signal and to separate the L+R signal, the pilot signal, and the L-R signal, respectively, from the digital signal;

and

clock reconstitution circuitry adapted to receive the pilot signal from the second digital filter and to reconstitute a clock signal from the pilot signal.

With regard to the first element, the Examiner cites Richards as teaching "first (fig. 1 #29), second (fig. 1 #30) and third (fig. 1 #27) filters adapted to separate the L+R signal, the pilot signal, and the L-R signal, respectively, from the signal (col. 3 ln.17-29);" however, element #30, cited by the Examiner as comprising the second filter, is actually not a filter at all, but a demodulator. Even assuming *arguendo* that the Examiner's correspondence of Richards' elements to the claimed first, second, and third filters is correct, clearly, only the third filter (element #27) is "adapted to receive the digital signal," as recited in claim 1; the other two "filters" are adapted to receive the output of filter #27. Additionally, there is not a one-to-one correspondence of filters to signals (L+R, pilot, and L-R) as required by claim 1. The deficiencies of Richards in this regard are not remedied by Gibson, which was cited by the Examiner for its teaching of digital filters and which does not disclose a filter for separating the pilot signal from the digital signal.

With regard to the second element, the Examiner cites elements #31 and 35 of Richards as reading on the claimed "clock restitution circuitry;" however, again, assuming *arguendo*, that element #30 reads on the claimed second filter, elements #31 and 35 clearly fail to be adapted to receive a pilot signal from the element #30, as required by the claim language. Gibson, which, as previously noted, was cited by the Examiner for its teaching of digital filters, clearly fails to remedy the deficiencies of Richards in this regard.

In view of the foregoing, it is apparent that the combination of Richards and Gibson cannot be applied to reject independent claim 1 under 35 U.S.C. §103 because the combination fails to teach, suggest, or render obvious the claimed subject matter for at least the reasons set forth above.

Independent claims 13 and 18 include limitations similar to those of claim 1 and are therefore also allowable for at least the same reasons discussed above with respect to claim 1. Claims 2-12, 14-17, 19, and 20 depend from and further limit claims 1, 13, and 18, and are therefore also deemed to be in condition for allowance over the cited references.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness with respect to the pending claims has clearly not been met, and the rejection under U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

There is still another, mutually exclusive, and compelling reason why the Richards and Gibson references cannot be applied to reject independent claims 1, 13, and 18 under 35 U.S.C. §103.

§2142 of the MPEP also provides

[T]he examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

In this context, the MPEP further provides at §2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Recently, the Supreme Court ruled that the longstanding "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed any valid reason why a person of ordinary skill in art would have been motivated to combine the teachings of Richards and Gibson in the manner recited in independent claims 1, 13, and 18. In particular, the Examiner's statement that the motivation for combining the two references "would have been to reduce the

number of parts needed to implement the circuit of Richards" is not accurate, given that the combination of the teachings of Richards and Gibson as suggested by the Examiner would actually increase the number of parts (in particular, by at least an analog-to-digital converter and one or more digital-to-analog converters). As a result, the Examiner has presented no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of the claims.

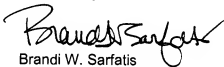
Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection of independent claims 1, 13, and 18, as well as all claims dependent therefrom, under 35 U.S.C. §103 should be withdrawn.

Conclusion

It is clear from the foregoing that independent claims 1, 13, and 18 are in condition for allowance. Claims 2-12, 14-17, and 19-20 depend from and further limit independent claims 1, 13, and 18 and are therefore also deemed to be in condition for allowance.

An early formal notice of allowance of claims 1-20 is requested.

Respectfully submitted,


Brandi W. Sarfatis
Registration No. 37,713

Dated: August 1, 2007
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75212-3789
Telephone: 214/651-5896
IP Facsimile No. 214/200-0853
File #: 22768.21

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office, on the date indicated below.

Date: August 1, 2007


Ellen Lovelace